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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS BERGER, ULRICH KANTER,
HELLFRIED KARPf, and WERNER ZIEGLER

Appeal 2008-5186
Application 09/854,560
Technology Center 3600

Decided: December 31, 2008

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-18 and 31. Claims 19-30 and 32 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a method for automating the management of operating materials and supplies of an analyzing system, preferably for use in medical, environmental, or food technology environments (Specification, 1:1-6). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method for automation of the management of required operating materials and/or supplies of an analyzer or analyzing system used to determine a parameter or a parameter group of a sample used in medical, environmental or food technology, said required operating materials being selected from the group consisting of sensors, sensor cartridges, tubes, seals and software components and tagged as to types and maximum useful lives, and said required supplies being selected from the group consisting of cleaning media, quality control media, calibrating media, and ink cartridges and tagged as to types, expiry dates and quantities, comprising:

(a) automatically detecting and recording said types and maximum useful lives of said required operating materials, and said types, expiry dates and quantities of said required supplies,

(b) entering a desired frequency of analysis, or automatic calculation of an estimated frequency of analysis from past frequencies of use of said analyzer or analyzing system,

(c) automatically calculating an amount of said operating materials and/or supplies required per unit of time, based on data obtained in steps (a) and (b),

(d) determining an optimum point in time for ordering more of said required operating materials and/or supplies, taking into account

the maximum useful lives of said required operating materials, the expiry dates and quantities of said required supplies, and

(e) automatically ordering said operating materials and/or supplies via remote data transmission.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

LoBiondo	US 5,305,199	Apr. 19, 1994
Sano	US 5,415,840	May 16, 1995
Namisniak	US 5,711,160	Jan. 27, 1998

The following rejections are before us for review:

1. Claims 1-4 and 31 are rejected under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak.
2. Claims 5-18 are rejected under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak and further in view of Sano.

THE ISSUE

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-4 and 31 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak. This issue turns on whether it would have been obvious to one of ordinary skill in the art to combine the disclosures of LoBiondo and Namisniak to meet the claimed limitations.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claims 5-18 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak and further in view of Sano. This issue turns on whether it would have been obvious to one of ordinary skill in the art to combine the disclosures of LoBiondo, Namisniak, and Sano to meet the claimed limitations.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence¹:

FF1. LoBiondo discloses a reprographic machine that includes an inventory tracking system for monitoring consumable supplies (Abstract).

FF2. LoBiondo shows that a counter 24 is provided for each consumable supply item being tracked such as paper, toner, and ink cartridges. A judgment means 36 and microprocessor show and alert the operator that a reorder is needed (Col. 3:47-4:28).

FF3. LoBiondo discloses that the frequency of analysis can be selected by the operator on the touch screen (Col. 4:17-28).

FF4. Namisniak has disclosed a system in which expiry dates for food are monitored and the user is sent a message when the food item's expiry date is about to expire (Fig. 6, Col. 6:11-58).

FF5. Sano discloses a liquid sample automatic analyzer (Abstract).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the

improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellants argue that the rejection of claims 1-4 and 31 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak is improper because LoBiondo’s system is only based on quantity information for the consumable supplies and not the expiry data (Br. 4-5). The Appellants also argue that Namisniak does not show automatically detecting and recording the expiry dates of the required supplies since the user manually enters this information into an input device such as a keypad (Br. 7-8). The Appellants further argue that LoBiondo and Namisniak do not disclose the limitation of claim 1 for “automatically calculating an amount of said operating materials and/or supplies required per unit time, based on data obtained in steps (a) and (b)”.

In contrast, the Examiner has found that while LoBiondo does not disclose detecting maximum useful lives and expiry dates for materials or

supplies that Namisniak does (Br. 5, 7). The Examiner maintains that since LoBiondo discloses making the systems features automatic it would been obvious to make the manual features automatic in the combination of the references (Br. 7).

We agree with the Examiner. LoBiondo discloses a system in which components such as toner and ink are monitored based on used amounts and that the operator is sent a replacement message when required (FF1&2). LoBiondo also discloses that the frequency of analysis can be selected by the operator on the touch screen (FF3). Namisniak discloses a system in which expiry dates for an item are monitored and the user is sent a message when the item's expiry date is about to expire (FF4). While LoBiondo is directed to photocopying equipment and Namisniak is directed to stored foods they are interrelated teachings in that both references are attempting to notify a user electronically when items need to be replaced or used. The Supreme Court noted in *KSR* that often it will be necessary "to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.*, 127 S. Ct. at 1740-41. The modification of the system of LoBiondo to take into account the expiry dates of components as disclosed by Namisniak is considered a combination of familiar elements to obtain the predictable result of being able to provide a warning electronically when any item has reached its useful lifetime and needs to be replaced. The application of the monitoring of the other elements in the photocopying device such as sensors in addition to consumables is considered an obvious modification to monitor the entire

system. In *KSR* the Court held that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar elements in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” Here, extending the monitoring to other elements in the photocopier, such as sensors, would be obvious to one of ordinary skill in the art. LoBiondo has disclosed automating the process and the modification of the system of LoBiondo by Namisniak to further include the automatic detection and recording of the expiry dates of the supplies would be readily obvious to one of ordinary skill in the art in making the combination. Having the combined systems automatically calculate the amount of supplies required per unit time would be obvious to one of ordinary skill in the art to monitor how fast consumable supplies are being used.

For the above reasons the rejections of claims 1 and 31 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak is sustained. The Examiner has not separately argued the patentability of dependent claims 2-4 and the rejection of these claims is sustained for the same reasons above.

The Appellants have argued that the rejection of claims 5-18 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak and Sano is improper because Sano fails to overcome the deficiencies of LoBiondo and Namisniak. The Appellants have failed to separately argue and address claims 5-18. Accordingly the rejection of claims 5-18 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak and Sano is sustained for the same reasons as above.

With regards to claims 11 and 13, the automatic ordering of supplies disclosed by LoBiondo may be considered to meet the claimed limitations

for a “service” or “maintenance” job. Regardless, the Appellants’ argument merely recites the limitations in these claims, and this is not considered a separate argument for the patentability of these claims. See 37 C.F.R. § 41.37 (o) (1) (2008). For this reason the rejection of claims 11 and 13 is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-4 and 31 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak.

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 5-18 under 35 U.S.C. § 103(a) as unpatentable over LoBiondo in view of Namisniak and Sano.

DECISION

The Examiner’s rejection of claims 1-18 and 31 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 09/854,560
Application 2008-5186

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